

REMARKS

The Office Action dated July 2, 2008, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Status of the Claims

Claims 14-26 have been amended to more particularly point out and distinctly claim the subject matter of the invention. New claims 27-36 have been added. No new matter has been added. Thus, claims 14-36 are currently pending in the application and are respectfully submitted for consideration.

Information Disclosure Statement

Applicant respectfully notes that reference AA (U.S. Publication No. 2002/0065785 to Tsuda) was not initialed as being considered in the form PTO-1449 attached to the outstanding Office Action. Applicant respectfully requests that the Examiner include form PTO-1449 with all references initialed with the next Office Action.

Claim Objections

Claims 15-26 were objected to due to informalities. Specifically, the Office Action stated on page 2 that “‘A method’ should be ‘The method’.” The claims have been amended herein to accommodate the Examiner’s request. However, Applicant respectfully notes that the MPEP permits dependent claims to start with “A”.

Accordingly, it is respectfully submitted that the objection is overcome and respectfully requested that the objection be withdrawn.

Rejection under 35 U.S.C. § 101

Claims 25 and 26 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Office Action stated on page 2 that “the claimed invention may be directed to software per se”. Claim 25 has been amended into apparatus form and claim 26 has been amended into means-plus-function form.

Accordingly, it is respectfully submitted that the rejection is overcome or rendered moot and respectfully requested that the rejection be withdrawn.

Rejections under 35 U.S.C. § 102

Claim 14 was rejected under 35 U.S.C. § 102(e) as being anticipated by McIntosh et al. (U.S. Publication No. 2003/0139180). The Office Action took the position on page 4 that McIntosh et al. discloses all of the features of claim 14. Applicant respectfully traverses the rejection. Reconsideration of claim 14 is respectfully requested.

Independent claim 14, from which claims 15-24 depend, recites a method of providing an accounting service in a mobile communication system, including accessing a chargeable functionality of the communication system by a user by authenticating the user by an authentication/authorization server, and by authorizing the access of the user by the authentication/authorization server. The method also includes indicating, by the authentication/authorization server, a specific accounting server out of several possible

accounting servers dependent on the user. The accounting server is physically separated from the authentication/authorization server.

As will be discussed below, McIntosh et al. does not disclose or suggest all of the features of the presently pending claims.

McIntosh et al. generally discusses “a communication system and a method for using the same to couple a wireless local area network (WLAN) to public and private telephone networks to enable communication between user equipment terminals associated with the WLAN and the telephone networks” (paragraph [0002]). The communication system may enable “a user to access a public network through low powered unregulated user equipment terminals (UEs) or transceivers” (see paragraph [0013], of McIntosh et al.). “Generally, the communication system includes a public cellular network and a wireless local area network (WLAN) coupled to the public cellular network, the WLAN configured to facilitate communication between the UEs and the public cellular network. The public cellular network can be a global system for mobile communications (GSM) network coupled to a public switched telephone network (PSTN)” (*Id.*).

Independent claim 14 recites, in part, “indicating, by said authentication/authorization server, a specific accounting server out of several possible accounting servers dependent on the user”. The Office Action took the position on page 4 that these features are disclosed by paragraph [0096] of McIntosh et al. Applicant respectfully disagrees.

The cited section of McIntosh et al. discusses that:

In yet another embodiment, inter-working capability between RADIUS based accounting and current GSM call data records or CDRs is accomplished by use of a separate accounting server (not shown). This accounting server receives the RADIUS accounting data from the access points 128A, 128B, 128C, converts the data into GSM based CDRs, for example, based upon subscriber profile, and transfers it to the billing entity using file transfer protocol (FTP).

As can be seen from the above, McIntosh et al. discusses that a separate accounting server may be used. However, nothing is cited or found in McIntosh et al. that discloses or suggests indicating, by an accounting/authorization server, a specific accounting server **out of several possible accounting servers**, as claimed. Rather, it appears from McIntosh et al. that only a **single** separate accounting server may be used to provide interworking capability between RADIUS based accounting and GSM call data records. Further, even were McIntosh et al. to disclose multiple accounting servers, which is not admitted (and in fact the accounting server is not even shown in McIntosh et al.), nothing is cited or found in McIntosh et al. that discloses that an indication of the accounting server is **dependent on the user**, as claimed.

Per the above, McIntosh et al. does not disclose or suggest all of the features of claim 14 under 35 U.S.C. § 102(e). Accordingly, it is respectfully submitted that the rejection is overcome and respectfully requested that the rejection be withdrawn.

Claims 14-17 and 19-23 were rejected under 35 U.S.C. § 102(a) as being anticipated by Ala-Laurila et al. (WO 01/76297). The Office Action took the position on pages 4-6 that Ala-Laurila et al. discloses all of the features of the rejected claims.

Applicant respectfully traverses the rejection. Reconsideration of the claims is respectfully requested.

Applicant points out that while the Office Action rejected the above claims under 35 U.S.C. § 102(a), page 12 of McIntosh et al. is, in part, relied upon in rejecting claim 14 (in addition to Ala-Laurila et al.). Applicant respectfully notes that multiple references generally cannot be used in making a 35 U.S.C. § 102 rejection. In fact, MPEP § 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a **single** prior art reference.’ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)” (emphasis added). Accordingly, Applicant respectfully notes that the rejection is improper and must be withdrawn.

Applicant also respectfully notes that if an art-based rejection rejecting these claims is presented in the next Office Action, said rejection would be presented for the first time and as such, would not have been given “second or subsequent consideration” on the record under 37 C.F.R. § 1.113. Accordingly, if an art-based rejection of these claims is presented in the next Office Action, the next Action **cannot** be made final.

However, even though the rejection of these claims is improper, Applicant presents the following arguments regarding why the present claims distinguish over the cited art in order to expedite prosecution.

Ala-Laurila et al. generally discusses “authentication and billing of a mobile station connecting to a mobile IP (Internet Protocol) network” (page 1, lines 4 and 5).

“[T]he packet data network uses the external mobile telecommunications network for billing” and sends billing data to an accounting server of the external telecommunications network (see page 1, line 31, through page 2, line 9, of Ala-Laurila et al.). “The GSM telecommunications network operator bills the user for both the authenticating/roaming services and for the use of public IP access networks” (page 8, lines 11-13, of Ala-Laurila et al.).

Per the above, independent claim 14 recites, in part, “indicating, by said authentication/authorization server, a specific accounting server out of several possible accounting servers dependent on the user”. The Office Action took the position on page 5 that these features are disclosed by page 12, lines 1-9, of Ala-Laurila et al. Applicant respectfully disagrees.

The Office Action stated on page 5 that the cited section of Ala-Laurila et al. discloses “(a) an accounting server of an external telecommunication network is considered as physically separated from said authentication/authorization server (b) the user identity is used to generate billing data and sending the billing data to the corresponding accounting server”. The cited section of Ala-Laurila et al. discusses “an overview of the authentication ... by reference to the signals used during the authentication process” (see page 11, lines 5 and 6). As can be seen from the above, Ala-Laurila et al. discusses that billing data may be sent to an accounting server of an external telecommunications network. However, nothing is cited or found in Ala-Laurila et al. that discloses, teaches or suggests indicating, by an accounting/authorization server, a

specific accounting server **out of several possible accounting servers**, as claimed. Rather, it appears from Ala-Laurila et al. that data is only sent to a **single** accounting server in an external telecommunications network. Further, even were Ala-Laurila et al. to disclose multiple accounting servers, which is not admitted, nothing is cited or found in Ala-Laurila et al. that discloses that an indication of the accounting server is **dependent on the user**, as claimed. While a user ID, information of the costs, a user class and a user's billing record may be provided (see page 13, tables 1-3 of Ala-Laurila et al.), Ala-Laurila et al. is silent as to providing an indication of an **accounting server** dependent on the user, as claimed.

Claims 15-17 and 19-23 depend from claim 14 and add further features thereto. Thus, the arguments above with respect to independent claim 14 also apply to the dependent claims.

Per the above, Ala-Laurila et al. fails to disclose or suggest all of the features of the above-rejected claims under 35 U.S.C. § 102(a). Further, per the above, McIntosh et al. also fails to disclose or suggest all of these features. Accordingly, it is respectfully submitted that even were a proper 35 U.S.C. § 102 or 103 rejection presented for these claims, said rejection would be overcome at least by the reasoning presented above.

Rejection under 35 U.S.C. § 103

Claims 18 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ala-Laurila et al. Claims 18 and 24 depend from claim 14 and add further features thereto. Thus, the arguments above with respect to independent claim 14 also apply to

claims 18 and 24. Further, Applicant respectfully submits that the application of Official Notice with respect to claim 24 is improper.

With respect to Official Notice, the MPEP states that “such rejections should be judiciously applied” (see MPEP § 2144.03). “Official notice without documentary evidence to support an [E]xaminer’s conclusion is permissible only in some circumstances” (see MPEP § 2144.03(A)). “It would not be appropriate for the [E]xaminer to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of **instant and unquestionable** demonstration as being well-known” (see *Id.*, emphasis added).

Here, the Office Action stated on page 7 that “the use of digital signature is a well-known technology in the field. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use digital signature when exchanging messages between the authentication/authorization server and the accounting server.” However, no evidence for this conclusory statement is present in the record. Further, per the above, the facts asserted as well-known must be capable of instant and unquestionable demonstration as being well-known, and Applicant respectfully submits that such is not the case here. If the Examiner continues to believe that the use of a digital signature signed by the authorization/authentication server so that the fact that the authentication/authorization server made the ticket can be verified by the accounting server would have been obvious, Applicant respectfully requests that the Examiner provide a reference in the next Office Action offering evidence that this is the case. The

legal standard for applying Official Notice under MPEP § 2144.03 is rigorous, and the present application of Official Notice falls short of meeting this high standard.

Accordingly, it is respectfully submitted that the rejection is overcome and respectfully requested that the rejection be withdrawn.

New Claims

New claims 27-36 have been added. Claims 27-36, which each have their own scope, depend from apparatus claim 25 and recite similar features to claims 15-24, respectively. Accordingly, it is respectfully submitted that the new claims patentably distinguish over the cited art for at least the reasons discussed above with respect to the independent claims.

Conclusion

For at least the reasons presented above, it is respectfully submitted that claims 14-36, comprising all of the currently pending claims, patentably distinguish over the cited art. Accordingly, it is respectfully requested that the claims be allowed and the application be passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: Petition for Extension of Time
Additional Claim Fee Transmittal
Check No. 019800 (\$286.00)